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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/469,561	12/22/1999	MARTIN PAGEL	61135/P016US/10106022	5104
29053 7590 09/18/2009 FULBRIGHT & JAWORSKI L.L.P 2200 ROSS AVENUE SUITE 2800 DALLAS, TX 75201-2784			EXAMINER WU, RUTAO	
			ART UNIT	PAPER NUMBER
			3628	
			MAIL DATE	DELIVERY MODE
			09/18/2009	PAPER

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* MARTIN PAGEL
9

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11 Appeal 2009-003102
12 Application 09/469,561
13 Technology Center 3600
14

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16 Decided: September 18, 2009
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20 *Before:* MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU
21 R. MOHANTY, *Administrative Patent Judges.*

22
23 CRAWFORD, *Administrative Patent Judge.*
24

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26 DECISION ON APPEAL

1 STATEMENT OF THE CASE

2 Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection
3 of claims 1 to 4, 6 to 14, 16 to 19, 21 to 27, 30 to 34 and 37 to 51. We have
4 jurisdiction under 35 U.S.C. § 6(b) (2002). Appellant appeared for oral
5 hearing on August 13, 2009.

6 Appellant invented a postal printer driver method (Spec. 1).

7 Claim 1 under appeal reads as follows:

8 1. A method of printing a data stream being
9 presented to a printer, said data stream adapted to
10 enable said printer to print on one or more sheets
11 of paper information in accordance with said data
12 stream, said data stream containing data bits useful
13 for controlling functions additional to said printing
14 information in accordance with said data stream,
15 said method comprising:
16 abstracting at least a portion of said data bits
17 from said data stream with a postal printer driver,
18 wherein said data stream is provided by an
19 application which has not been adapted to control
20 said additional functions and said abstracting
21 includes examining said data stream for data
22 patterns native to output of said application;
23 using at least some of said abstracted data
24 bits for controlling at least one of said additional
25 functions, wherein said at least one of said
26 additional functions comprises printing of a
27 postage indicia; and
28 creating, from said abstracted data bits, a
29 separate data stream for controlling the printing of
30 said postage indicia.

31 The prior art relied upon by the Examiner in rejecting the claims on
32 appeal is:

33 Harman US 5,684,706 Nov. 4, 1997

The Examiner rejected claims 1 to 4, 6 to 14, 16 to 19, 21 to 27, 30 to 34 and 37 to 51 under 35 U.S.C. § 103(a) as being unpatentable over Harman.

ISSUES

Has Appellant shown that the Examiner erred in rejecting claim 1 because Harman does not disclose a data stream provided by an application which has not been adapted to control additional functions?

Has Appellant shown that the Examiner erred in rejecting claim 17 because Harman does not disclose abstracting which includes examining a data stream for pre-established data patterns which include the beginning and ending of postage data?

Has the Appellant shown that the Examiner erred in rejecting claim 23 because Harman does not disclose reviewing said data stream to create therefrom a separate data stream for controlling additional functions with respect to printing of documents?

FINDINGS OF FACT

Harman discloses a system having multiple user input stations and multiple mail preparing apparatus for preparing and franking mail (col. 1, ll. 1 to 4). A word processing application 30 provides data to a driver 37 (Fig. 3). The word processing application 30 executes a conventional merge application to merge variable data 32 which includes name, address, and other variables to be printed on the documents with a previously input form 36 to create document data (col. 4, ll. 39 to 42). The driver 37 creates job data (col. 4, ll. 44 to 45; Fig. 3). The job data includes a job header 12, mail

1 piece header 18 and document data 20. The job header 12 includes mail
2 piece data defining default attributes for each mail piece in the job, including
3 the number of document sheets to be accumulated for each mail piece,
4 whether or not a pre-printed insert is to be added to the document sheets, the
5 manner in which the accumulated sheets are to be folded, whether or not a
6 business return envelope is to be inserted and whether or not the mail piece
7 is to be moistened and sealed (col. 3, ll. 57 to 65). The job header 12 may
8 also include whether or not an envelope data is present, whether mail pieces
9 include a uniform number of document sheets and whether or not inserts
10 vary among the mail pieces (col. 3, l. 66 to col. 4, l. 3). Mail piece header 18
11 includes the same (or a subset of the) mail piece data elements included in
12 the job header 12 regarding the specific mail piece (col. 4, ll. 14 to 17).

13 In one embodiment, a mail center controller 4 appends postage value
14 for each mail piece in the appropriate field in header 18 (col. 5, ll. 21 to 23).
15 In another embodiment, a controller 100 accesses a per item weight data
16 base 117 and postal rate data base 119 to determine the weight of the mail
17 piece and determine the appropriate postage value for the mail piece (col. 5,
18 ll. 57 to 60). The postage costs are then sent to mail center controller 4 for
19 allocation of the costs to user accounts (col. 5, ll. 63 to 65).

20 Job data is sent to parser 112 from mail center controller 4 (col. 7, ll.
21 44 to 45; Fig. 5). Parser 112 outputs document data from field 20 to the
22 page description language interpreter 114, the envelope data from field 22 to
23 envelope data buffer 118, default attribute data from job header 12 and mail
24 piece data attribute data from mail piece header 18 to mail piece attribute
25 generator 116 (col. 7, ll. 47 to 55).

PRINCIPLES OF LAW

An invention is not patentable under 35 U.S.C. § 103 if it is obvious. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 427 (2007). The facts underlying an obviousness inquiry include: Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). In addressing the findings of fact, “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR* at 416. As explained in *KSR*:

If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida* and *Anderson's-Black Rock* are illustrative - a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

KSR at 417.

A prior art reference is analyzed from the vantage point of all that it teaches one of ordinary skill in the art. *In re Lemelson*, 397 F.2d 1006, 1009

1 (CCPA 1968) (“The use of patents as references is not limited to what the
2 patentees describe as their own inventions or to the problems with which
3 they are concerned. They are part of the literature of the art, relevant for all
4 they contain.”). Furthermore, “[a] person of ordinary skill is also a person of
5 ordinary creativity, not an automaton.” *KSR* at 421. The obviousness
6 analysis need not seek out precise teachings directed to the specific subject
7 matter of the challenged claim, for a court can take account of the inferences
8 and creative steps that a person of ordinary skill in the art would employ. *Id.*
9 at 418.

10 On appeal, Applicants bear the burden of showing that the Examiner
11 has not established a legally sufficient basis for combining the teachings of
12 the prior art. Applicants may sustain their burden by showing that where the
13 Examiner relies on a combination of disclosures, the Examiner failed to
14 provide sufficient evidence to show that one having ordinary skill in the art
15 would have done what Applicants did. *United States v. Adams*, 383 U.S. 39,
16 52 (1966).

17 ANALYSIS

18 We agree with the Appellant that the Examiner erred in rejecting
19 claim 1 because Harman does not disclose a data stream provided by an
20 application which has not been adapted to control additional functions. In
21 the Examiner’s view, the driver 37 combined with the word processing
22 application 30 can be considered the application recited in claim 1 and the
23 parser 112 is the postal driver that does the abstracting (Ans. 24). However,
24 even if the Examiner is correct that the driver 37 and word processing
25 application 30 together can be considered the application recited in claim 1,
26

1 this combined application *is* adapted to control other functions. This is so
2 because the job data outputted from the application (30/37) includes data to
3 control various other additional functions i.e., the number of document
4 sheets to be accumulated for each mail piece, whether or not a pre-printed
5 insert is to be added to the document sheets, the manner in which the
6 accumulated sheets are to be folded, whether or not a business return
7 envelope is to be inserted, whether or not the mail piece is to be moistened
8 and sealed, whether or not an envelope data is present, whether mail pieces
9 include a uniform number of document sheets, and whether or not inserts
10 vary among the mail pieces (col. 3, l. 66 to col. 4, l. 3).

11 Therefore, we will not sustain the Examiner's rejection as it is
12 directed to claim 1 and claims 2, 3, 4, 6 to 14, 16, 18, 19, 21, 22, 47 and 48
13 dependent thereon. We will likewise not sustain the rejection as it is
14 directed to claim 33 and claims 34, 37 to 40, 42 to 46 and 50 dependent
15 thereon because claim 33 also requires an application which has not been
16 adapted to control additional printing operations.

17 We agree with the Appellant that the Examiner erred in rejecting
18 claim 17 because Harman does not disclose abstracting which includes
19 examining a data stream for pre-established data patterns which include the
20 beginning and ending of postage data. The Examiner relies on the data
21 pattern depicted in Figure 2 for teaching these features. The Examiner
22 reasons that a pre-established data pattern in the job data stream is shown
23 and that job header 12 includes data relating to the postage indicia and is
24 separated from other data in the data stream by unique separators (Ans. 25).
25 Although the Examiner is correct that job data 12 includes data relating to
26 postage indicia and that job data 10 is separated by unique separators 26-1,

1 26-2 . . . , the Examiner has not established that the postage data in job data
2 12 is separated by unique separators. In addition, the Examiner has not
3 established that the job data 10 is examined by the parser 112, which the
4 Examiner finds is the printer driver, for pre-established data patterns or that
5 these patterns include the beginning and ending of postage indicia data.
6 Parser 112 outputs data from job header 12 and mail piece data attribute data
7 from mail piece header 18 to mail piece attribute generator 116 (col. 7, ll. 47
8 to 55). There is no indication in Harman that any of the data is examined
9 and certainly no disclosure that the data is examined for pre-established
10 patterns that include a beginning and ending of postage indicia data.

11 Therefore, we will not sustain the Examiner's rejection of claim 17
12 and claim 49 dependent thereon. We will likewise not sustain the rejection
13 of claim 41 and claim 51 dependent thereon because claim 41 also recites a
14 control program for examining a data stream for pre-established patterns
15 which includes the beginning and ending of postage indicia data.

16 We agree with the Appellant that the Examiner erred in rejecting
17 claim 23 because we agree with the Appellant that Harman does not disclose
18 reviewing said data stream to create *therefrom* a separate data stream for
19 controlling additional functions with respect to printing of documents. The
20 Examiner is of the view that a separate data stream is created when data
21 from postal rate data base 119 is added to the data stream. Even if the
22 Examiner is correct Harman does not disclose that the data stream is
23 reviewed and that the separate data stream for controlling additional
24 functions is created from the data stream.

25 Therefore, we will not sustain the rejection of claim 23 and claims 24
26 to 27 and 30 to 32 dependent thereon.

1 CONCLUSION OF LAW

2 On the record before us, Appellant has shown that the Examiner erred
3 in rejecting the claims on appeal.

4

5 DECISION

6 The decision of the Examiner is reversed.

7

8 REVERSED

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